

II. Remarks/Arguments

Claims 2-6, 8-14, 27, and 46-50 were previously pending. Claim 46 has been amended. Reconsideration of presently pending claims 2-6, 8-14, 27, and 46-50 is respectfully requested in light of amendments and the following remarks.

Rejections Under 35 U.S.C. § 102

Claims 2-6, 9-10, 13-14, 27, and 46-50 were rejected under 35 U.S.C. §102(b) as being unpatentable over Begley, et al. (US Patent No. 6,211,056 B1, hereinafter “Begley”). Applicant respectfully traverses this objection on the grounds that the Examiner has not shown how Begley teaches each limitation contained within the Claims of the current application as required by the statute. Specifically, the Examiner asserts that Begley teaches “creating an air gap in said layer of dielectric, said air gap surrounding said inductor (Fig. 5).” However, this is not the case. As previously argued, Fig. 5 in Begley does not teach having an air gap surrounding the inductor; rather, Begley teaches an air gap surrounding a dielectric material which surrounds an inductor. The patent specification and the previous and present prosecution history make clear that having an “air gap surrounding the inductor” does not include intermediate dielectric material.¹

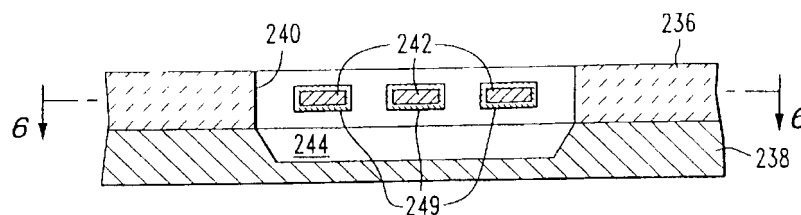


FIG. 5

In the current Office Action, the Examiner rejects this argument by way of an analogy: “a pencil is on a table, whether it is on a piece of paper, which is on the table, or whether it is directly on the table without an intervening layer.” However, this analogy is inapt for two reasons. First of all, we are talking about electric circuits here. If in the Examiner’s analogy the pencil and table are conductive, an intermediate piece of paper would change the entire electrical circuit. Similarly, adding an air gap around an inductor modifies the B/H curve of the inductor, as described in the present application.

Second, this argument contradicts the direct teaching of Begley. Begley teaches that, in his device, there exist “nitride sheaths 249 that *surround* the metal 242 in each trench” (Col. 4, ll. 39-40,

¹ The recent decision in *Phillips v. AWH Corp.*, 415 F.3d 1303 (Fed. Cir. 2005) instructs that each claim term in the patent must be read in favor of the intrinsic evidence.

emphasis added), rather than an “air gap surrounding said inductor material” as described in Claims 2 and 46 of the present application.

For these reasons, the rejection based on 35 U.S.C. 102(b) should be withdrawn and the claims allowed.

Rejections Under 35 U.S.C. § 103

Claims 8, 11, and 12 were rejected under 35 U.S.C. §103(a) as being unpatentable over Begley, et al. (US Patent No. 6,211,056 B1, hereinafter “Begley”) in view of Zhao, et al. (US Patent No. 2002/0148807 A1 hereinafter referred to as “Zhao”). This rejection is respectfully traversed. The Examiner’s rejection incorporates the discussion about Begley, above. For each of the reasons discussed above, Begley does not teach nor anticipate the “air gap surrounding said inductor material” as taught in the present application. Therefore, the rejection based upon 35 U.S.C. 103(a) should be withdrawn.

Claims 46–50

As noted above, Claim 46 was added in the last response as an independent claim. Claims 47–50 have been added as dependent claims, and each of claims 47–50 limits claim 46 further. In the previous office action, the Examiner did not specifically disclosed any objection to claims 46-50. To further clarify claim 46, however, Applicant has amended Claim 46 to state that the air gap is “located adjacent to and surrounding said inductor material.” As demonstrated above, Begley does not teach nor anticipate the “air gap adjacent to and surrounding said inductor material” as taught in the present application. Applicant respectfully submits that independent claim 46 is patentable over the cited art and is in condition for allowance.

Premature Final Rejection – Finality Should be Withdrawn

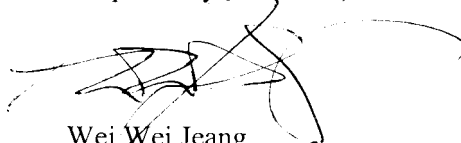
Applicants respectfully submit that the Office Action is not complete. More specifically, in the current Office Action, the Examiner states that “Claims . . . 46-50 are rejected under 35 U.S.C. 102(b) as being anticipated by Begley et al (US 6,211,056 B1).” While the Examiner did specify why she considered the other Claims to be anticipated by Begley, claims 46-50 were not otherwise discussed.

MPEP §707.07(i) provides that “[i]n every Office action, each pending claim should be mentioned by number and its treatment or status given.” Considering that Claim 46 is an independent claim newly presented in the last response, and that claims 47-50 depend from Claim 46, a final rejection is not appropriate without providing a detailed response to each claim.

Conclusion

Applicant respectfully submits that independent claims 2 and 46 are in condition for allowance. Claims 3-6, 8-14 and 27 depend from and further limit independent claim 2; claims 47-50 depend from and further limit independent claim 46. Dependent claims 3-6, 8-14, 27, and 47-50 are therefore allowable as well. An early formal notice of allowance of claims 2-6, 8-14, 27, and 46-50 is requested. An early action on the merits is respectfully requested.

Respectfully submitted,



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